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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,795	12/21/2000	Charles A. Drake		4636

7590 03/05/2003

Rodney B Carroll
Conley Rose P C
5700 Granite Parkway Suite 330
Plano, TX 75024

EXAMINER

NORTON, NADINE GEORGIANNA

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 03/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,795

Applicant(s)

DRAKE ET AL.

Examiner

Nadine Norton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s) _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

DETAILED ACTION

Withdrawal of Objection to the Specification

Applicant's amendment submitted 12-17-02 in paper no.8 is sufficient to overcome the previous objection to the specification.

Withdrawal of Claim Rejections Under 35 USC § 112

Applicant's amendment submitted 12-17-02 in paper no.8 is sufficient to overcome the previous 112 rejection of claims.

Withdrawal of Claim Rejections Under 35 USC § 102 and/or 103

Applicant's arguments/amendments submitted 12-17-02 in paper no.8 are sufficient to overcome the previous rejections over Landis et al.(4,967,030)

Withdrawal of Double Patenting Rejection

Applicant's submission of a proper terminal disclaimer 11-13-02 in paper no.9 are sufficient to overcome the previous double patenting rejection over application no. 09/718,044.

Withdrawal of Claim Rejections Under 35 USC § 103

Applicant's statement of common ownership in the response filed 12-17-02 in paper no.8 overcomes the previous 103 provisional rejection over application 09/718,044.

Claim Rejections - 35 USC § 102/103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-11 and 15-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Harandi et al.(5,019,357).

The reference of Harandi et al.(5,019,357) discloses a process which involves the production of an intermediate oligomerization product. See abstract, lines 6-21 and column 3, lines 45-50. Typical feedstocks include the presence of hydrogen. See column 2, lines 24-28. The intermediate oligomerization product is contacted with a ZSM-5 catalyst to obtain a hydrocarbon product. See column 10, lines 64-68. The ZSM-5 may be combined with a group VIII metal such as platinum. See column 6, lines 20-35.

The reference teaches second stage process conditions including a temperature of 230-315°C and a pressure of 600 psig. See column 11, lines 1-15.

The reference of Harandi et al.(5,019,357) succeeds at disclosing a process involving the processing of applicant's claimed feed (an oligomer) under conditions overlapping those claimed by applicants. It is noted that the reference is silent about the specific increase in viscosity and reduction in pour point. However, applicant's specific viscosity increase and pour point

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reduction would inherently be accomplished because the same feed is subjected to overlapping conditions which are considered to form the same product.

Applicant's process is anticipated by the process of Harandi et al.(5,019,357) because it discloses essentially the same steps involving the treatment of an oligomer with a ZSM-5/group VIII metal catalyst.

Applicant's viscosity increase and pour point reduction would obviously be produced upon operating the process of Harandi et al.(5,019,357).

Claim Rejections - 35 USC § 103

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harandi et al.(5,019,357).

It is noted that the reference is silent about the amount of Group VIII (e.g. platinum) in the ZSM-5 catalyst.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a ZSM-5 catalyst with any amount of group VIII metal in the process of Harandi et al.(5,019,357), including the specific amounts defined in applicant's claims, because it has been held that there is no invention where the difference in proportions is not critical and was ascertained by routine experimentation. In re Swain and Adams, 70 USPQ 412 (CCPA 1946).

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Response to Arguments

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Prior Art of Record

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The attached references disclose the treatment of oligomeric charges with ZSM-5 compositions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nadine Norton whose telephone number is 703-305-2667. The examiner can normally be reached on Monday through Thursday from 8:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 703-308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0661.

N.N.
March 3, 2003

**NADINE G. NORTON
PRIMARY EXAMINER**

